

**In The Drawings**

Please amend Fig. 15 of sheet 8 as shown on the enclosed marked-up-in-red copy thereof. A revised formal drawing is enclosed under separate cover addressed to the Chief Draftsman. Acknowledgment of receipt of the formal drawing sheet and its acceptance into the file is requested.

### REMARKS

Fig. 15 of the drawings is amended to correct an inadvertent error. Support for the amendment is provided by the originally-filed application at page 14, line 17.

New claims 55-59 are added. Support for the new claims is provided by the originally-filed application at, for example, Figs. 9 and 15 and pages 7-11.

Claims 42-44 and 49-52 are allowed.

Claims 34-36 and 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-33, 41, 45-47 and 53-54 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Agahdel, et al (U.S. Patent No. 5,402,077). Claim 37 is rejected under 35 U.S.C. §103(a) as being obvious over Agahdel, et al.

Before discussing rejections, the Examiner requested that Applicant reiterate in this response a discussion held during an Examiner Interview of September 7, 2005. During the interview, the Examiner's attention was directed to a clear error in a reproduced Fig. 4 for which the Examiner provides in the pending Action (pg. 3 of paper no. 0605) to illustrate alleged teachings for rejecting the claims. The error is that the Examiner has inadvertently provided in the reproduced Fig. 4 an arrow entitled "lateral dimension of substrate" which **clearly does not correspond** to the lateral dimension of the substrate. The alleged teaching of the substrate relied upon by the Examiner is represented by the contact pad 40. The arrow entitled "lateral dimension of substrate" clearly has a dimension greater than a lateral dimension of the contact pad 40 (substrate), and therefore, the arrow clearly does

not represent the lateral dimension of the substrate as it states. The importance of this error is clearly understood with the following discussion.

Claim 31 recites a projection supported over a *substrate and comprising material of the substrate* and wherein the **projection** comprises a lateral dimension less than a lateral dimension of the **substrate**. Agahdel fails to teach or suggest this positively recited limitation. To allegedly teach this limitation, the Examiner reproduces a portion of Fig. 4 of Agahdel at page 3 of the Action and which is discussed on page 2 of the Action. However, the interpretations of the teachings of Agahdel on page 2 of the Action are inconsistent with the figure on page 3 of the Action. Either interpretation fails to teach limitations of claim 31.

More specifically, the substrate 40 discussed on page 2 of the Action relies on 40 to teach the substrate and the projection. However, reference 40 has the same lateral dimension which fails to disclose the limitation of claim 31. Further, the larger dimension disclosed on page 3 of the Action identified as allegedly disclosing the lateral dimension of the substrate is not disclosed as corresponding to material which is the same material of the substrate. Accordingly, either interpretation of Agahdel fails to disclose the projection comprising material of the substrate **and** having a lateral dimension less than a lateral dimension of the substrate. Claim 31 is allowable over Agahdel for at least this reason. If claim 31 is not allowed, Applicant requests clarification of the teachings relied upon by the office in a non-final Action in accordance with 37 CFR 1.104(b) ("the examiner's action will be complete as to all matters") so Applicant may appropriately respond during prosecution of this application as is his right.

Claims 32-41, 45-47 and 55 depend from independent claim 31, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

For example, regarding the obviousness rejection against claim 37 based on modifying Agahdel, claim 37 recites apexes have a selected projecting distance, the projecting distance being about one-half the thickness of a conductive pad which the apparatus is adapted to engage. The Examiner correctly states this limitation is not taught, but adds that it would be obvious "to have set the range of acceptable projecting distances to meet the selected criteria because claim 37 exhibits limiting conditions determined by routine experimentation" and cites to case law, the most recent being a CCPA case decided in **1946** (*In re Swain and Adams*, citations omitted) (emphasis added) (pg. 6 of paper no. 0605).

However, a more recent CCPA decision has eviscerated dependence on "routine experimentation" in an obvious rejection. The CCPA court decision of *In re Yates* stated: the **"emphasis upon routine experimentation is contrary to the last sentence of section 103"**. *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 n. 4 (CCPA 1981) (emphasis added). Based on this evidence alone, the rationale for the Examiner's obviousness rejection against claim 37 is improper and should be withdrawn. Claim 37 is allowable.

Moreover, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite

motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine or modify references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead that individual to combine or modify the relevant teachings of the references. The Court additionally stated that the factual question of motivation is material to patentability and **can not be resolved on subjective belief and unknown authority**. **The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.**

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The only rationale is the subjective opinion of the Examiner improperly based upon Applicants' own disclosure. For "routine experimentation" to even be arguably applicable in the instant situation, the Examiner would have to provide some objective evidence of record that it is desirable to modify the apexes of the Agahdel device to have a selected projecting distance *of any dimension* from that specifically taught by Agahdel. Without this evidence, it can not be reasonably stated that there would be any motivation for routine experimentation to modify or redesign the Agahdel device to have apexes with a projecting distance of any other projection distance than that already taught by Agahdel. This

required objective evidence to modify the Agahdel device simply does not exist in the art of record, and notably, the Examiner has failed to provide the location of such required objective evidence. There is no **suggestion of the desirability of doing what the inventor has done**, that is, to modify the Agahdel device to have the apexes with a selected projecting distance, the projecting distance being about one-half the thickness of the conductive pad which the apparatus is adapted to engage, as positively recited by claim 37. Pursuant to the above authority, claim 37 is allowable.

Claim 46 recites an **entirety** of the projection is **spaced** from the substrate. Agahdel does not teach the positively recited limitation. Moreover, the Examiner relies upon the projecting apexes of Agadel as allegedly disclosing the limitation of the **entirety** of the projection is spaced from the substrate recited by claim 46. However, the projecting apexes extend from the projection as disclosed in the reproduced Fig. 4 of Agahdel which fails to disclose or suggest the entirety of the projection or the entirety of the projection **spaced** from the substrate as claimed. Claim 46 is allowable for at least this reason.

Claim 47 recites the substrate comprises **bulk** silicon. The Examiner refers to col. 8, line 63 to col. 9, line 3 of Agahdel to allegedly teach this limitation. However, this section of Agahdel is directed to embodiments shown in Figs. 7A-7B which are different from and not relevant to the embodiment disclosed in Fig. 4 of Agahdel as reproduced and relied upon by the Examiner to allegedly teach the limitations of independent claim 31 from which claim 47 depends. The Examiner can not rely upon incompatibly disclosed embodiments of the reference to allegedly teach limitations of the claim. Accordingly, Agahdel does not teach the positively recited limitation of claim 47, and therefore, claim 47 is allowable.

Regarding the anticipation rejection against independent claim 53 based on Agahdel, claim 53 recites an entirety of the projection is **spaced** from the substrate. Agahdel does not teach the positively recited limitation. Moreover, the Examiner relies upon the projecting apexes of Agahdel as allegedly disclosing the limitation of the **entirety** of the projection is spaced from the substrate recited by claim 53. However, the projecting apexes extend from the projection as disclosed in the reproduced Fig. 4 of Agahdel which fails to disclose or suggest the entirety of the projection or the entirety of the projection **spaced** from the substrate as claimed. Claim 53 is allowable.

Claims 56-57 depend from independent claim 53, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Regarding the anticipation rejection against independent claim 54 based on Agahdel, claim 54 recites the substrate comprises **bulk** silicon. The Examiner refers to col. 8, line 63 to col. 9, line 3 of Agahdel to allegedly teach this limitation. However, this section of Agahdel is directed to embodiments shown in Figs. 7A-7B which are different from and not relevant to the embodiment disclosed in Fig. 4 of Agahdel as reproduced and relied upon by the Examiner to allegedly teach the additional limitations of claim 54. The Examiner can not rely upon incompatibly disclosed embodiments of the reference to allegedly teach limitations of the claim. Accordingly, Agahdel does not teach the positively recited limitation of claim 54, and therefore, claim 54 is allowable.


Claims 58-59 depend from independent claim 54, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their

own recited features which are not shown or taught by the art of record.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 10-6-05

By:   
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